REMARKS

In the Office Action[1] mailed June 2, 2011, the Examiner:

    a)   objected to claims 1, 10, and 18 because of informalities;

    b)   rejected claims 1, 3-4, 6-10, 12, 14-18, and 23-26 under 35 U.S.C. 103(a) as being unpatentable over Kadel (U.S. Patent Application Publication No. 2002/0184401, in view of Severin (U.S. Patent Application Publication No. 2005/0005251 further in view of Worden (U.S. Patent Application Publication No. 2003/0149934); and

    c)   Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadel, Severin, Worden and Hejlsberg (U.S. Patent 6,920,461).

Amendment amends claims 1, 3, 4, 10, 18, 20-22. Support for the amendments can be found in the specification and claims as originally filed. In light of the claim amendments made herein and for the reasons stated below, Applicants request reconsideration and removal of the rejections, and allowance of the claims.

Formal Matters

Claims 1, 10, and 18 are objected to because of informalities. More specifically, the Examiner alleges on page 2 of the Office Action:

> the term recited as 'deriving' is not construed as having proper teaching that substantially support a accepted (lexicographic) meaning of the concept of or the verb to 'derive' (nowhere is shown how DOM tree elements are used to help <u>derive</u> anything); whereas the "API" --being derived from the claim language -- is not provided with proper Disclosure as to cause this 'API' <u>concept to be accepted according</u> to well-known lexicographic standards (nowhere is the Specifications show how DOM-

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[1] The Office Action may contain statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

based inputs serve to derive a API – a application program interface).
(Emphasis in original).

The Applicant respectfully traverses the objection, insofar as the objection is understood. The Applicant understands the objection to allege a lack of written description support for:

> generate code using the set of intermediate objects as inputs to derive Application Program Interface (API) enabling development tools to access the development objects to develop the application,

as claimed in claim 1 and similarly claimed in claims 10 and 18. If this correct, Applicant respectfully submits that at least paragraph [0074] of the specification, as originally filed, provides written support for this claimed feature. Paragraph [0074] discusses FIG. 11 which "is a block diagram of a process for API and XML schema derivation" (paragraph [0030], emphasis added). Paragraph [0074] recites:

> The Java objects 1130 represent the document object model (DOM) of the metamodel (e.g., represented as a DOM tree). Process 1100 uses Java objects 1130 as inputs to generators 1135, 1140, and 1145 to generate code that is included in metadata API 130 (emphasis added),

which fully supports the claimed element quoted above.

The Examiner further contends that "nowhere is shown how DOM tree elements are used to help derive anything" and "nowhere is the Specification show [sic] how DOM-based input serve to derive a API" (Office Action, page 2, emphasis in original). This is incorrect. At least paragraph [0074] specifically discusses using "Java objects 1130 [that] represent the document object model (DOM) of the metamodel" in a "process for API and XML schema derivation" (paragraph [0030], emphasis added). Moreover, paragraph [0074] specifically discusses how "Java objects 1130 that represent the document object model

(DOM) of the metamodel" are used to "generate code that is included in the metadata API 130."

Accordingly, Applicant respectfully submits that the objections to claims 1, 10, and 18 should be withdrawn.

Rejection Under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection under 35 U.S.C. 103(a) of claims 1, 3-4, 6-10, 12, 14-18, and 23-26 as being unpatentable over Kadel, in view of Severin and Worden and of claims 20-22 as being unpatentable over Kadel, Severin, Worden and Hejlsberg, insofar as the rejections are understood. A *prima facie* case of obviousness has not been established, at least with respect to the claims as amended.

"The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements." *M.P.E.P. § 2142, 8th Ed. (July 2010)(internal citation and inner quotation omitted).* "[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). In rejecting a claim, "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(III). Here, no *prima facie* case of obviousness

has been established for at least the reason that the scope and content of the prior art have not been properly determined nor have the differences between the claimed invention and the prior art been properly ascertained.

Claim 1 recites, in part, a computer-readable storage device storing a computer program product being operable to cause:

> generat[ion of] code using the set of intermediate objects as inputs to derive Application Program Interface (API) enabling development tools to access the development objects to develop the application.

The cited art fails to disclose or suggest at least these elements of claim 1, as amended.

In the Response to Arguments section of the Office Action (page 17), the Examiner explains the interpretation of "derive" in the claim element above that, presumably, is used in the rejection: "Based on the interpretation of 'deriving' and the nature of 'API' built upon DOM and expressed as schema, the language of the claim has been addressed." More specifically, the Examiner appears to invent an interpretation of the claim word "define," an invented definition he appears to implicitly admits is repugnant to its plain and ordinary meaning, because of an alleged lack of support in the written description:

> Absent proper support for such 'deriving an API' as claimed, this deriving (using Java objects from a DOM as INPUTS) will be interpreted as implementing developer's code (library-based APIs) pertinent to a top level module or application interface (e.g. a mediator API) that enables, based on instantiated APIs by the developer -- via using libraries therein - further manipulation and accessing of a wide variety of objects or data to further development of a target application, as set forth above in Kadel's teachings. (Emphasis added).

Even if the Examiner's allegations of a lack of support were correct, which

Applicant has shown above they are not, this would still be improper. In

particular, MPEP 2163 holds that, in the case of a lack of written description, the

claims should be rejected under 35 U.S.C. 112, first paragraph and:

> <u>Regardless of the outcome of that determination</u>, Office personnel
> must complete the patentability determination under all the relevant
> statutory provisions of title 35 of the U.S. Code. (Emphasis added).

There is no basis in either the MPEP or case law for re-defining a claim term for

obviousness analysis according to whether or not there is "proper support" in the

specification for the use of the term. Therefore, the rejection under 35 U.S.C.

103 is improper on this basis alone.

The Examiner admits on page 7 of the Office Action:

> Kadel does not explicitly disclose using the set of intermediate object as
> inputs to derive API code for enabling access and development objects
> (see Claim Objections).

On pages 7-9, the Examiner apparently attempts to account for these features with a

combination of Severin and Worden. However, the Examiner's proposed combination

of Kadel, Severin, and Worden is unclear. More specifically, the Examiner alleges on

pages 7-9 of the Office Action that:

> it would have been obvious for one of ordinary skill in the art to implement
> the capturing of XML schema and parsing of model in Kadel XIS
> development framework, so that intermediate objects (W3C type Java
> APIs, or intropection/reflection APIs - as set forth above) gathered from or
> discovered by the process of parsing - as in SAX API or DOM API --
> **would be inputs for developing editing (e.g. annotation to a tree
> view), discovery, validating/converting or schema manipulating code
> (XML marshalling or re-generating APIs as in Severin; or Kadel:
> resolution 1480 – Fig. 14; Fig. 27, Fig. 30; tree window, JAF**

commands - 0348-0357, pg. 28) all of which made available in Kadel *for deriving executable classes* – based on pre-defined libraries

First of all, although the Examiner mentions aspects of Worden on pages 7-8, the Examiner fails to mention Worden explicitly in the combination. That is, there is no mention of Worden from the section that begins "it would be obvious[...]" on page 8 to the end of the rejection on page 9 of the Office Action. Accordingly, the Examiner fails to explicitly identify which features of Worden are included in the above-quoted combination and to explain how those features are included. Therefore, the rejection fails at last to "[ascertain] the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). Moreover, the Examiner merely asserts that "intermediate objects (W3C type Java APIs, or introspection/reflection APIs [...] would be inputs for developing editing [...], discovery, validating/converting or schema manipulating code (XML marshalling or re-generating APIs as in Severin" without providing <u>any</u> evidentiary support.[2] That is, even if the Examiner's assertion were correct that "W3C type Java APIs, or introspection/reflection APIs" are "intermediate objects," which Applicant does not concede, the Examiner does not even appear to argue that any of the cited art discloses "using the set of intermediate objects as inputs to derive [...] API) enabling development tools," as claimed.[3]

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[2] M.P.E.P. 2144.03.A: "[A]ssertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art <u>must always be supported</u> by citation to some reference work recognized as standard in the pertinent art." *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. (Emphasis Added).

[3] The Examiner has admitted that this feature is not taught in Kadel (see Office Action, page 7) and does not cite Worden as providing the claimed feature.

If, on the other hand, the Examiner means to rely on Severin for the claimed "using the set of intermediate objects as inputs to derive [...] API) enabling development tools," this is incorrect. Severin discloses a "Component Integration Engine" (title). As Severin discloses in paragraph [0041], the invention of Severin is a "tool provid[ing] meta-implementations for many <u>existing</u> APIs" (emphasis added), not for "deriv[ing...] API) enabling development tools," as claimed. Paragraph [0042] of Severin further discloses "creating a meta-implementation descriptor for the <u>existing</u> APIs in a programming language." Although the portion of the rejection is unclear, the Examiner cites paragraph [0107] of Severin on page 7 of the Office Action possibly meaning to indicate that paragraph [0107] discloses this feature. In fact paragraph [0107] actually discloses "automatically convert[ing] any object to and from an XML metadata format," not "deriv[ing...] API) enabling development tools," as claimed. Although paragraph [0107] mentions several type of format conversion (e.g., "to and from an XML metadata format," "convert from unknown XML formats to the expected metadata formats," "access XML in structured formats other than the standard metadata format to convert XML to objects and objects to XML), it does not disclose "deriv[ing...] API) enabling development tools," as claimed. Therefore, Severin fails to cure the deficiencies of Kadel at least with respect to:

> generat[ion of] code using the set of intermediate objects as inputs to
> derive Application Program Interface (API) enabling development tools to
> access the development objects to develop the application,

as claimed in claim 1. Worden and Hejlsberg fail to cure the deficiencies of Kadel and Severin with respect to at least this claimed feature.

Accordingly the Office Action has failed to properly determine the scope and content of the prior art, and has failed to properly ascertain the differences between the prior art and the claimed combinations. For at least these reasons, no prima facie case of obviousness has been established for claim 1, and the Examiner should withdraw the rejection of the claim under 35 U.S.C. § 103(a). Independent claims 10 and 18, as amended, recite similar elements as above and, therefore, the rejections under 35 U.S.C. 103 of these claims should be withdrawn for at least reasons similar to those given above with respect to claim 1.

Moreover, the rejections under 35 U.S.C. §103 of claims depending from independent claims 1, 10, and 18 are improper and should be withdrawn for at least reasons given above with respect to the independent claims

CONCLUSION

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing the claims in condition for allowance. Applicant submits that the proposed amendments of the claims do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment

would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: September 2, 2011   By:

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